

REMARKS

Applicants thank the Examiner for consideration of the present application. Claims 1, 2, 4, 6-8, and 11-22 are currently pending in this application. Claims 1, 2, 6, 15-17, and 19-22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Publication No. 2002/0061260 to Husar (hereinafter “Husar”). Claims 4 and 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Husar in view of U.S. Patent No. 4,118,305 to Oloman et al. Claims 7 and 8 stand rejected under § 103(a) as being unpatentable over Husar in view of U.S. Patent No. 5,565,143 to Chan. Claim 14 stands rejected under § 103(a) as being unpatentable over Husar in view of U.S. Patent No. 5,922,604 to Stapleton et al. Finally, claim 18 stands rejected under § 103(a) as being unpatentable over Husar in view of U.S. Publication No. 2001/0027745 to Weigl et al. Applicants respectfully traverse these rejections and request reconsideration of each of the rejected claims in light of the remarks presented herein.

Applicants would like to take this opportunity to clarify what they believe to be error in the rejections maintained by the Examiner in the May 13, 2010, Final Office Action. For the Examiner’s reference, Applicants’ pending claim 1 reads as follows:

1. A device for analyzing a biological liquid sample comprising a composite body of a plurality of layers of flat materials defining two or more sample channels for transporting the sample liquid from an application site to a measuring site wherein

the plurality of layers of flat material comprise a plurality of transport layers arranged in a stack-like manner between two support layers,

the transport layers each comprise two sections having opposing edges which comprise side walls of the sample channels,

the sides of the support layers that face the transport layers are coated with an electrode layer comprising an electrically conductive material, and

the support layers are displaced relative to one another in a step-like manner, such that the electrode layers comprise a connecting section extending beyond an adjacent transport layer.

Regarding this claim, the Examiner has asserted that Husar teaches that the “side of the support layer 3 that faces the transport layer 2 is coated with an electrode layer 17” Office Action mailed May 13, 2010, at p. 2. Responding to the Applicants’ argument that Husar lacked this teaching, the Examiner further stated that:

It should be noted that the limitation “electrode layer” is subject to the broadest reasonable interpretation. That said, Husar discloses that membrane layer 17 can comprise electrodes (see claim 24 and [0124], note that “planar disposable” referred to in [0124] refers to layer 17). Thus, any layer that comprises electrodes is deemed to be within the scope of the limitation ‘electrode layer,’ including layer 17 disclosed by Husar. The Examiner maintains the position that the claims and the Husar reference were properly construed.

Office Action mailed May 13, 2010, at p. 6 (emphasis added). Applicants respectfully assert that the Examiner has misinterpreted the disclosure of Husar, which does not teach or suggest that the “membrane layer 17 can comprise electrodes.” Thus, the Examiner has improperly relied on the Husar reference to support his rejection of claim 1 under § 102(b).

The requirements for a reference to anticipate under 35 U.S.C. § 102 are quite clear. The MPEP provides that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987)). The Federal Circuit has held that “unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN v. Verisign*, 545 F.3d 1359, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008) (emphasis added).

The Examiner's rejection of claim 1 relies on a reference that fails to meet the standard for anticipation. While Husar does generally teach that electrodes may be included in some embodiments of the disclosed devices (see Husar [0081], [0124]-[0126]), Husar does not teach an electrode layer arranged or combined with the other claimed components in the same way as recited in the claim. In fact, Husar neither shows electrodes anywhere in the figures nor expressly discloses where electrodes could or would be incorporated into the devices. Rather, the Husar reference teaches only the following regarding the addition of electrodes:

The planar disposable allows to integrate the sample well and cell manipulation (e.g. cell poration, electric poration), cell fusion or cell positioning). More process steps can be integrated. The arrangement is such as to permit to easily integrate moving and poration electrodes in order to separate cells and cell porations from each other.

Electroplating methods or vapour deposition processes make it possible to provide the disposable (similarly to the way for an electric poration cuvette) with electrodes (e.g. in aluminum, gold). The distance between electrodes may be largely chosen at will here. The cells treated by electric poration can be dispensed again after the operation along with the disposable which can also be a proportioning disposable. There is no need for refilling them into the electric poration cuvette and filling them back via pipette tips.

Spiral-shaped electrode structures which are employed for cell fusion may be substituted for by planar meander-shaped or comb-shaped electrode structures on the planar disposable.

Id. at [0124]-[0126]. Applicants submit that this disclosure does not teach or suggest that the electrodes are incorporated in any particular location or component of the device.

In finding to the contrary—namely, that the membrane layer 17 can comprise electrodes—the Examiner relies on an incorrect interpretation of the term “planar disposable.” As used in the Husar reference, the term “planar disposable” refers to the entire device 1, not to the membrane layer 17. Husar expressly defines the word “disposables” to refer to the disclosed “devices for handling liquid samples.” *See id.* at [0070]. Husar then teaches that “[a]ll of the

disposables comprise two or more planar elements" and, thus, refers to these devices as "planar disposables" in several parts of the specification. *See id.* at [0078], [0099]-[0126]. Thus, the above-cited paragraphs of Husar teach only that electrodes may be incorporated into some unspecified portion of the device. The Examiner also misinterprets claim 24 of the Husar reference. Rather than reciting that the membrane comprises electrodes, as the Examiner asserts, claim 24 recites that "the device for handling liquid samples (1) has at least one additional functional element which is a membrane (17) and/or . . . an electrode . . ." *See id.* at Claim 24 (emphasis added). Like the portions of Husar discussed above, this claim merely recites that the device itself may generally include an electrode (and/or a membrane), not that the electrode is incorporated in the membrane.

Therefore, while the Husar reference may teach a device generally including one or more electrodes, it does not expressly teach a device including an electrode layer arranged or combined in the same way specifically recited in claim 1. In particular, the disclosure does not teach or suggest that "the sides of the support layers that face the transport layers are coated with an electrode layer," as required by claim 1. Likewise, the disclosure does not teach or suggest that "the electrode layers comprise a connecting section extending beyond an adjacent transport layer," as also required by claim 1. As a result, Husar cannot support a rejection under Section 102 because it fails disclose "all of the limitations arranged or combined in the same way as recited in the claim." *Net MoneyIN*, 88 USPQ2d at 1759.

Moreover, the May 13, 2010 Office Action does not set forth the factual analysis necessary to show that the missing elements are inherent in Husar. In establishing anticipation through inherency, the rule is that "[i]nherency, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is

not sufficient.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (quoting *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981)). The rejection cannot rely on Husar to disclose inherently the missing elements without extrinsic evidence that makes “clear that the missing descriptive matter is necessarily present.” MPEP 2131.01(III) (quoting *Continental Can*, 948 F.2d at 1269). The Examiner’s rejection does not include reference to such evidence.

In summary, Husar fails to teach a device in which “the sides of the support layers that face the transport layers are coated with an electrode layer” or in which “the electrode layers comprise a connecting section extending beyond an adjacent transport layer,” as required by claim 1. For at least this reason, Applicants submit that Husar cannot prove prior disclosure of the claimed subject matter and, thus, cannot anticipate claim 1 under 35 U.S.C. § 102(b). Applicants respectfully ask the Examiner to withdraw the rejection of independent claim 1.

Each of the remaining claims 2, 4, 6-8, and 11-22 depend directly or indirectly from claim 1 and include all the limitations of that claim. Thus, the Examiner’s reliance on the Husar reference in the rejections of these claims is improper for at least the reasons stated above. In addition, the secondary references relied on by the Examiner in rejecting claims 4, 7, 8, 11-14, and 18 fail to cure this deficiency of Husar. Applicants respectfully ask that the Examiner also withdraw the rejections of claims 2, 4, 6-8, and 11-22.

CONCLUSION

In view of the foregoing, this application is believed to be in a condition for allowance. Action to that end is hereby solicited. If there are any questions or comments that would speed prosecution of this application, the Examiner is invited to call the undersigned at (317) 231-6422. Applicants believe that no fees are due with this response. If necessary for this paper to constitute a timely response to the May 13, 2010, Final Office Action, the Commissioner is hereby authorized to charge any fees which may be due to the Account of Barnes & Thornburg LLP, Deposit Account No. 10-0435, with reference to file 21084 US-pd/d.

Respectfully submitted,

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